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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/998,234	12/03/2001	Jonathan L. Rowlands	TI-29978	5084

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EXAMINER

HENNING, MATTHEW T

ART UNIT	PAPER NUMBER
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2131

DATE MAILED: 09/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/998,234

Applicant(s)

ROWLANDS, JONATHAN L.

Examiner

Matthew T. Henning

Art Unit

2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 2,5,6,9,11,12 and 15-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,7,8,13 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) 1-17 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

1 This action is in response to the communication filed on 6/24/2005.

2 **DETAILED ACTION**

3 ***Election/Restrictions***

4 Restriction to one of the following inventions is required under 35 U.S.C. 121:

- 5 I. Claims 1, 3-4, 7-8, and 13-14, drawn to a system for distributing content in a
6 secure manner, classified in class 713, subclass 193, subject matter wherein
7 unauthorized access to information held in static memory elements is prevented.
- 8 II. Claims 2, and 9-12, drawn to a system for distributing content wherein the content
9 is only partially functional upon distribution, classified in class 713, subclass 201,
10 subject matter including means or steps for providing system security at network
11 level.
- 12 III. Claims 5-6, and 15-17, drawn to a content distribution system including tickets
13 for providing authorization, classified in class 713, subclass 156, subject matter
14 wherein a central trusted authority provides digital information attesting to a
15 network computers legitimacy.

16 The inventions are distinct, each from the other because of the following reasons:

17 Inventions I, II, and III are related as subcombinations disclosed as usable together in a
18 single combination. The subcombinations are distinct from each other if they are shown to be
19 separately usable. In the instant case, invention I has separate utility such as content key
20 distribution using public keys, invention II has separate utility such as sampling or previewing
21 content prior to purchasing the content, and invention III has separate utility such as
22 authorization to receive content via a ticketing system. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Election by Original Presentation

Newly amended claims 2, 9, and 11-12 of invention II are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: invention II has separate utility such as sampling or previewing content of a lesser quality prior to purchasing the full quality content, and newly amended claims 5-6, and 15-17 of invention III are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: invention III has separate utility such as authorization to receive content via a ticketing system multiple pieces of content can be authorized for receipt at the same time.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 2, 5-6, 9-12, and 15-17 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

As such, claims 1, 3-4, 7-8, and 13-14 have been examined.

Response to Arguments

Applicant's arguments with respect to claims 1, 3-4, 7-8, and 13-14 have been considered but are moot in view of the new ground(s) of rejection.

All objections and rejections not set forth below have been withdrawn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, and 7-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Saito (US Patent Number 6,449,717).

Regarding claim 1, Saito disclosed a method of data distribution preserving rights of a remote party (See Saito Abstract and Fig. 1) comprising the steps of: an authorized user locally transmitting data to a receiver (See Saito Fig. 1 and Col. 6 Lines 34-36); and following said locally transmitting step, authorizing the receiver's use of the data by a trusted agent (See Saito Col. 6 Lines 48-65).

Regarding claim 7, Saito disclosed that said step of locally transmitting data includes directly connecting an apparatus of the authorized user to an apparatus of the receiver (See Saito Col. 12 Lines 9-10).

Regarding claim 8, Saito disclosed that said step of locally transmitting data includes employing a local connection having a first bandwidth; and said step of authorizing includes

employing a network having a second bandwidth less than said first bandwidth (See Saito Col. 12 Lines 1-2 and 9-10).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-4, and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Downs et al. (US Patent Number 6,574,609) hereinafter referred to as Downs, and further in view of Saito.

Regarding claim 3, Downs disclosed a method of data distribution preserving rights of a remote party comprising the steps of: the sender choosing an encryption key for the receiver's use (See Downs Col. 22 Lines 17-19); the sender encrypting the data using the key (See Downs Col. 22 Lines 17-19); the sender encrypting the encryption key using a public encryption key of a trusted agent (See Downs Col. 22 Lines 20-21); the sender locally transmitting both the encrypted data and the encrypted key to the receiver (See Downs Col. 22 Lines 30-59 and Col. 23 Lines 36-41); the receiver and the trusted agent negotiating licensing and payment for the data (See Downs Col. 22 Line 60 – Col. 23 Line 28); the receiver transmitting the encrypted key to the trusted agent (See Downs Col. 22 Line 60 – Col. 23 Line 28); the trusted agent decrypting the encryption key (See Downs Col. 23 Lines 22-23); and the trusted agent sending the decrypted

1 encryption key to the receiver to receive the full data (See Downs Col. 23 Lines 22-28), but
2 Downs failed to disclose that the encrypted data could be transmitted prior to the license
3 negotiation and key transmission.

4 Saito teaches a content distribution system in which a first user provided a second user
5 with encrypted content, followed by the second user negotiating use of the content and receiving
6 the decryption key from a trusted agent (See Saito Fig. 1 and related text).

7 It would have been obvious to the ordinary person skilled in the art at the time of
8 invention to employ the teachings of Saito in the content distribution system of Downs by
9 transferring content directly from a first user to a second user followed by the second user
10 negotiating license and usage of the content and acquiring the decryption key for the content.
11 This would have been obvious because the ordinary person skilled in the art would have been
12 motivated to provide more flexible distribution of the content while protecting the interests of the
13 copyright owner of content.

14 Regarding claim 4, the combination of Downs and Saito disclosed the receiver choosing a
15 new encryption key unknown to the sender and encrypting the data with the new encryption key
16 (See Downs Col. 79 Lines 26-37).

17 Regarding claim 13, the combination of Downs and Saito disclosed that said step of
18 locally transmitting both the encrypted data and the encrypted key includes directly connecting
19 an apparatus of the sender to an apparatus of the receiver (See Saito Col. 12 Lines 9-10).

20 Regarding claim 14, the combination of Downs and Saito disclosed that said step of locally
21 transmitting both the encrypted data and the encrypted key includes employing a local
22 connection having a first bandwidth; and said steps the receiver transmitting the encrypted key to

Art Unit: 2131

the trusted agent and the trusted agent sending the decrypted encryption key to the receiver both include employing a network having a second bandwidth less than said first bandwidth (See Saito Col. 12 Lines 1-2 and 9-10).


Conclusion


Claims 1, 3-4, 7-8, and 13-14 have been rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew T. Henning whose telephone number is (571) 272-3790. The examiner can normally be reached on M-F 8-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Matthew Henning
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9/8/2005


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